R E M A R K S

1.   Claims 1-70 and 119-121 are pending in this
Application. Reconsideration and further prosecution of the
above-identified application are respectfully requested in view
of the discussion that follows.

        Claims 1-70 and 119-121 have been rejected under 35
U.S.C. §112, first paragraph. Claims 8-12, 14, 16-20, 23-31, 49-
51, 53-56, 60, 62-63, 67 and 69 have been rejected under 35
U.S.C. §112, second paragraph. Claims 1, 3-35, 37-39, 43-44, 47-
57, 60-63, 67-70 and 119-121 have been rejected under 35 U.S.C.
§102(e) as being anticipated by U.S. Pat. No. 6,263,314 to
Donner. Claims 1-41, 43-44, 47-57, 60-63, 67-70 and 119-121 have
been rejected under 35 U.S.C. §102(e) as being anticipated by
U.S. Pat. No. 6,393,406 to Eder. Claims 42, 45-46, 58-59 and 64-
66 have been rejected under 35 U.S.C. §103(a) as being obvious
over Donner, Eder and U.S. Pat. No. 5,136,646 to Haber et al.
Claims 2, 40 and 41 have been rejected under 35 U.S.C. §103(a) as
being obvious over Donner and Eder. After a careful review of
the claims (as amended), it has been concluded that the
rejections are improper and should be withdrawn.

2.   Claims 4-6, 8-70 and 74-95 have been rejected under 35
U.S.C. 112, first paragraph. In this regard, the Examiner
asserts that "The applicant's specification does not disclose
adequate structure for performing the recited function" (Office
Action of 10/7/05, page 3). However, "The first paragraph of
§112 requires nothing more than objective enablement . . . How
such a teaching is set forth, either by the use of illustrative
examples or by broad terminology, is of no importance" (In re
Marzocchi & Horton, 169 USPQ 367 (CCPA, 1971).

Some discussion of 'those skilled in the art' is necessary to frame the discussion. Applicant's invention is a new method and device for the evaluation of trade secrets. Thus, those skilled in the art are those already experienced in the evaluation of trade secrets by other means, including judges, intellectual property attorneys, and intellectual asset management professionals.

An applicable analogy here is to a new type of saddle for horse riding. Surely, those skilled in the art in this case would include those people who already know how to ride a horse with other types of saddles. Thus a complete description in the specification for a patent on such a saddle does not require a discussion of horsemanship in general. Clearly, those skilled in the art would include anyone who is already accomplished in the riding of a horse.

Judges are instructed by §757 of The Restatement (First) of Torts to consider the six factors of a trade secret in adjudicating trade secret disputes, and have been doing so for over sixty years since its publication in 1939. Every trade secrets case includes an analysis by the judge of the extent to which the alleged trade secrets meet the six factors. Attorneys involved in these cases must also perform such analyses in preparing for and trying these cases, knowing that the judge will perform such an evaluation at trial. There is a great deal of precedential and experiential background for such analyses.

Applicant seeks allowance of a patent on numerical methods of applying the six factors of the Restatement (First) of Torts to the evaluation of trade secrets. With regard to each of Examiner's objections under 35 USC § 112, Applicant asserts that either 1) the claimed subject matter is sufficiently described in the specification to enable a person skilled in the evaluation of trade secrets by other means to make and/or use the invention, or

-32-

2) the claimed subject matter is the general case of a novel, useful and non-obvious system of which one or more species are described in the specification.

The Examiner's objection to claims 1 and 119-121 in the first paragraph of page 3 of the Office Action, that adequate structure is not disclosed within the specification with regard to means within the programmed computer for providing a predetermined criteria for evaluating a potential trade secret, is in error. The computer described in the specification includes a User Interface Device both in the text of the specification and in Figure 1. The User Interface Device is sufficient means for "providing a predetermined criteria for evaluating a potential trade secret" to the user. The predetermined criteria itself may take several forms in different species of the invention; the example questionnaire provided in Table C of the specification is one specific example. The User Interface Device of the specification is sufficient means for displaying the questionnaire and the other possible forms of the predetermined criteria.

The Examiner suggests that there is inadequate disclosure for "means for characterizing (whether the trade secret constitutes negative know-how, whether the trade secret is a combinational trade secret)" (Office Action of 10/7/05, page 3). However, FIG. 1 clearly shows a User Interface Device. As would be well known to those of skill in the art, a check box on the User Interface Device and associated software as described in Appendix I would clearly constitute "means for characterizing (whether the trade secret constitutes negative know-how, whether the trade secret is a combinational trade secret)".

The Examiner suggests that there is inadequate disclosure for "means for specifying security measures". However, FIG. 1 clearly shows a User Interface Device. As would be known to

those of skill in the art, an interactive box on the User
Interface Device and associated software as described in Appendix
I (pages 22-23) would clearly constitute "means for specifying
security measures".

The Examiner suggests that there is inadequate disclosure
for "means for associating said security measures with a trade
secret". However, FIG. 1 clearly shows a User Interface Device.
As would be known to those of skill in the art, an interactive
box on the User Interface Device and associated software as
described in Appendix I would clearly constitute "means for
associating said security measures with a trade secret".

The Examiner suggests that there is inadequate disclosure
for "means for specifying". However, FIG. 1 clearly shows a User
Interface Device. As would be known to those of skill in the
art, an interactive box on the User Interface Device and
associated software as described in Appendix I would clearly
constitute "means for specifying" whatever is necessary to
specify for the protection of trade secrets.

The Examiner suggests that there is inadequate disclosure
for "means for determining which security measures are needed".
However, FIG. 1 clearly shows a User Interface Device. As would
be known to those of skill in the art, an interactive box on the
User Interface Device and associated software as described in
Appendix I (pages 21-22) would clearly constitute "means for
determining which security measures are needed" based upon the
value of the trade secret.

The Examiner suggests that there is inadequate disclosure
for "means for specifying security threats". However, FIG. 1
clearly shows a User Interface Device. As would be known to
those of skill in the art, an interactive box on the User
Interface Device and associated software as described in Appendix
I (page 22) would clearly constitute "means for specifying

-34-

security threats" based upon the type of trade secret.

The Examiner suggests that there is inadequate disclosure for "means for analyzing the ratio". However, FIG. 1 clearly shows a User Interface Device and FIG. 12 clearly shows a security processor. As would be known to those of skill in the art, an interactive box on the User Interface Device, the security processor of FIG. 12 and associated software as described in Appendix I would clearly constitute "means for analyzing the ratio" based upon the type of trade secret.

The Examiner suggests that there is inadequate disclosure for "means for specifying values for the six factors of a trade secret". However, FIG. 1 clearly shows a User Interface Device. As would be known to those of skill in the art, an interactive box on the User Interface Device, the content of Table C and associated software as described in Appendix I would clearly constitute "means for specifying values for the six factors of a trade secret" based upon the type of trade secret.

The Examiner suggests that there is inadequate disclosure for "means for determining employee exposure to a trade secret". However, FIG. 1 clearly shows a User Interface Device. As would be known to those of skill in the art, an interactive box on the User Interface Device, employee records and associated software as described in Appendix I (pages 35-36) would clearly constitute "means for determining employee exposure to a trade secret" based upon the type of trade secret.

The Examiner suggests that there is inadequate disclosure for "means for characterizing employee exposure". However, FIG. 1 clearly shows a User Interface Device. As would be known to those of skill in the art, an interactive box on the User Interface Device, employee records and associated software as described in Appendix I (pages 35-36) would clearly constitute "means for determining employee exposure" based upon the type of

trade secret.

The Examiner suggests that there is inadequate disclosure for "means for characterizing security risk". However, FIG. 1 clearly shows a User Interface Device. As would be known to those of skill in the art, an interactive box on the User Interface Device, competitor intelligence data and associated software as described in Appendix I (pages 21-23) would clearly constitute "means for characterizing security risk".

The Examiner suggests that there is inadequate disclosure for "means for calculating from the specified security measures a security measures factor for a trade secret". However, FIG. 1 clearly shows a User Interface Device. As would be known to those of skill in the art, an interactive box on the User Interface Device and associated software as described in Appendix I (possibly using different weighted values for different security measures) would clearly constitute "means for calculating from the specified security measures a security measures factor for a trade secret".

The Examiner suggests that there is inadequate disclosure for "means for providing the predetermined criteria for evaluating". However, FIG. 1 clearly shows a User Interface Device. As would be known to those of skill in the art, an interactive box on the User Interface Device, evaluation data in Table C and associated software as described in Appendix I would clearly constitute "means for providing the predetermined criteria for evaluating".

The Examiner suggests that there is inadequate disclosure for "means for doing the calculation". However, FIG. 12 clearly shows an arithmetic processor. As would be known to those of skill in the art, an arithmetic processor would clearly constitute "means for doing the calculation".

In the second paragraph on page 3 of the office action,

Examiner asks "How is the calculation performed? The applicant has provided no formulas with which the applicant performs the calculation" and "How are the values weighted?" However, as would be clear to those of skill in the art, any of a number of different methods may be used. Simple methods may include simply totalizing a value of each security factor. Values may be weighted based upon potential injury caused by a breach.

In general, Applicant asserts that the independent claims are novel, useful, and non-obvious without regard to the calculation used, and claims all systems described by the independent claims without regard to the specific calculation. With regard to enablement, the specification gives two equations as examples, the average and the geometric mean ("multiplied and the sixth root taken of the product"). Average and geometric mean are mathematical terms in the public domain defined by equations available in any basic arithmetic text. Applicant has therefore supplied two equations, corresponding to species of the genus invention, thus providing enablement.

With regard to Examiner's questions about threshold values, similar arguments apply. Thresholds and weights may be determined based upon the value of the trade secret to the organization. Net present value and economic benefit of a trade secret may be calculated based upon profit and competitive factors. Characterizations as to whether the trade secret constitutes negative know-how may be based upon whether the secret produced a negative result (it didn't work) in a particular process or was less efficient or was even comparable to another secret.

The Examiner asserts that "applicant claims a means for calculating various weighted values of the six factors using logical and mathematical equations. The applicant has failed to provide the mathematical equations used to perform calculations".

However, a person of skill in the art would realize that some factors are more important or less important than others. Mathematical equations in this case can range from a simple total of the six factors or can be based upon a weighting factor based upon the general knowledge of the trade secret in the industry.

The Examiner inquires "How are the security threats factors calculated?". In this regard, Security threats factors may be based upon the value to the company and upon the risk of loss. In other regards, the applicant claims any means for calculating security threats that are within the scope of the invention.

The Examiner inquires "How is indexing performed, how are the trade secrets drafts converted into trade secret application?" In this regard, indexing is performed using a sequential numerical index as discussed on pages 16-17. Conversion may be accomplished using a deterministic one-way algorithm as clearly discussed on pages 39-40 of the specification.

3.   Claims 8-12, 14, 16-20, 23-31, 49-51, 53-56, 60, 62-63, 67 and 69 have been rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This assertion is made without any argument to which Applicant can respond. This rejection includes only two questions: "What is a combinational trade secret?" and "What is negative know-how?"

Both of these terms are defined in the specification, on pages 4 and 17 of the specification respectively. Further, both terms are well understood by those skilled in the evaluation of trade secrets, and are based on longstanding precedent in trade secret law. For 'combinational trade secret', see Imperial Chem. Indus. Ltd. v. National Distillers & Chem. Corp., 342 F.2d 737,

752 (2d Cir. 1965) and Salsbury Labs., Inc. v. Merieux Labs., Inc., 735 F.Supp. 1555, 1569 (M.D. Ga. 1989), aff'd 908 F.2d 706 (11th Cir. 1990). For 'negative know-how', see Affiliated Hospital Products, Inc. v. Baldwin, 373 N.E.2d 1000, 1006 (Ill.App. 1978) and Glaxo Inc. v. Novopharm Ltd., 931 F.Supp. 1280, 1299 (E.D.N.C. 1996), aff'd, 110 F.3d 1562 (Fed. Cir. 1997).

Rejection of the claims regarding combinational trade secret and negative know-how are thus improper and should be withdrawn. With regard to the other claims in this rejection, Examiner has failed to make any argument to support the rejection and to which Applicant can respond. Rejection of these claims is thus also improper and should be withdrawn.

4.   Claims 1, 3-35, 37-39, 43-44, 47-57, 60-63, 67-70 and 119-121 have been rejected as being anticipated by Donner. Examiner concludes that the claimed invention "does not result in a structural or functional difference with respect to the prior art and held not to serve as a limitation on the claim as long as the prior art system is fully capable of performing that function." In this rejection, Examiner cites In re Schreiber.

In Schreiber, "The Board first found that Harz discloses every limitation recited in claim 1. Several of the recitations in the claims, the Board concluded, merely set forth the function and intended use of the top and therefore did not require any structural feature other than those taught by Harz. The Board found that the structure disclosed by Harz is inherently capable of dispensing popcorn in the manner set forth in the claims, and that Schreiber's declaration did not provide enough details to prove that the structure disclosed by Harz is incapable of performing the claimed functions of Schreiber's invention."

The flaw in the Examiner's argument in relying upon

-39-

Schreiber is that a computer is more than simply a power supply and a processor (or a popcorn dispenser as in the Schreiber case). In order to function to achieve an intended purpose, a computer also contains software that defines the structure and functional features of the invention. Since Donner does not describe the functional features of the claimed invention, Donner clearly lacks the software structure of the claimed invention.

For example, Donner is limited to patents that are found within an existing intellectual property portfolio. In addition, Donner is directed to placing a value on patents rather than to any process for accounting for trade secrets.

Since Donner is limited to placing a value on an existing portfolio of patents, Donner would have no reason to provide the method steps of (or apparatus for) "providing a predetermined criteria for evaluating a potential trade secret of the plurality of potential trade secrets under each of the six factors of a trade secret from the First Restatement of Torts", "the programmed computer receiving a numerical score value for the potential trade secret under the predetermined criteria for each of the six factors", "the programmed computer calculating a metric from the received numerical score values under the six factors", "the programmed computer determining that the potential trade secret is a trade secret when the calculated metric exceeds a predetermined threshold value" or "ranking the potential trade secret with regard to another potential trade secret found among the plurality of potential trade secrets based upon the calculated metric".

In addition, there is clearly a functional relationship between the provision of criteria and the receiving of scores related to the six factors of a trade secret from the First Restatement of Torts. In particular, the independent claims each result in the creation of a ranked listing of trade secrets in a

trade secret portfolio. The trade secrets are ranked through the use of a numerical value derived from the judgment of the user in responding to a criteria of a questionnaire about the trade secret. The questionnaire provided to the user directs his responses to six questions that are the established precedent for a determination by a court of a legally protected status as a trade secret.

The presentation of the questionnaire based on the six factors of a trade secret to the user is thus functionally interrelated to the useful act of creating a listing of trade secrets in the ranked order in which they can be expected to pass legal muster, at least in the aggregated judgment of the user. Absent the questionnaire being related to the six factors of a trade secret from the First Restatement of Torts, the invention would fail to provide any information whatsoever on the expected legal status of the trade secret, which must be based on the six factors.

Since Donner is limited to placing a value on an existing portfolio of patents, Donner does not do the same or any similar thing in the same way as that of the claimed invention. Since Donner does not do the same or any similar thing, the rejections are improper and should be withdrawn.

5.   Claims 1-41, 43-44, 47-57, 60-63, 67-70 and 119-121 have been rejected as being anticipated by Eder. The Examiner again concludes that the claimed invention "does not result in a structural or functional difference with respect to the prior art and held not to serve as a limitation on the claim as long as the prior art system is fully capable of performing that function"

As above, the flaw in the Examiner's argument in relying upon Schreiber is that a computer is more than simply a power supply and a processor (or a popcorn dispenser as in the

Schreiber case). In order to function to achieve an intended purpose, a computer also contains software that defines the structure and functional features of the invention. Since Eder does not describe the functional features of the claimed invention, Eder clearly lacks the software structure of the claimed invention.

For example, Eder fails to provide any teaching or suggestion of the method step of (or apparatus for) "providing a predetermined criteria for evaluating a potential trade secret of the plurality of potential trade secrets under each of the six factors of a trade secret from the First Restatement of Torts", "the programmed computer calculating a metric from the received numerical score values under the six factors", "the programmed computer determining that the potential trade secret is a trade secret when the calculated metric exceeds a predetermined threshold value" or "ranking the potential trade secret with regard to another potential trade secret found among the plurality of potential trade secrets based upon the calculated metric".

In addition, and as discussed above, there is clearly a functional relationship between the provision of criteria and the receiving of scores related to the six factors of a trade secret from the First Restatement of Torts. In particular, the independent claims each result in the creation of a ranked listing of trade secrets in a trade secret portfolio. The trade secrets are ranked through the use of a numerical value derived from the judgment of the user in response to the criteria of the questionnaire about the trade secret. The questionnaire provided to the user directs his responses to six questions that are the established precedent for a determination by a court of a legally protected status as a trade secret.

The presentation of the questionnaire based on the six factors of a trade secret to the user is thus functionally interrelated to the useful act of creating a listing of trade secrets in the ranked order in which they can be expected to pass legal muster, at least in the aggregated judgment of the user. Absent the questionnaire being related to the six factors of a trade secret from the First Restatement of Torts the invention would fail to provide any information whatsoever on the expected legal status of the trade secret, which must be based on the six factors.

Since Eder clearly fails to teach or suggest any of these features, Eder clearly does not do the same or any similar thing in the same way as that of the claimed invention. Since Eder fails to teach the same or any similar thing, the rejections are believed to be improper and should be withdrawn.

6.   Claims 42, 45-46, 58-59 and 64-66 have been rejected under 35 U.S.C. §103(a) as being obvious over Donner, Eder and U.S. Pat. No. 5,136,646 to Haber et al. However, Haber et al. is merely directed to the time-stamping of documents. As such, the combination of Donner, Eter and Haber et al. fail to provide any teaching or suggestion of the method step of (or apparatus for) "providing a predetermined criteria for evaluating a potential trade secret . . . receiving a numerical score value for the potential trade secret under the predetermined criteria for each of the six factors". Since the combination fails to teach or suggest at least these claim elements, the combination fails to teach or suggest each and every claim element. Since the combination fails to teach or suggest each and every claim limitation, the rejections are improper and should be withdrawn.

9.   Claims 2, 40 and 41 have been rejected under 35 U.S.C.

-43-

§103(a) as being obvious over Donner and Eder. However, as demonstrated above, neither Donner and Eder contains any teaching regarding the evaluation or ranking of trade secrets. More specifically, the combination of Donner and Eder fails to provide any method step of (or apparatus for) "providing a predetermined criteria for evaluating a potential trade secret . . . receiving a numerical score value for the potential trade secret under the predetermined criteria for each of the six factors". Since the combination fails to teach or suggest at least these claim elements, the combination fails to teach or suggest each and every claim element. Since the combination fails to teach or suggest each and every claim limitation, the rejections are improper and should be withdrawn.

10. New method claims 122 and 123 have been added. Support for new claims 122 and 123 may be found in the claims as originally filed.
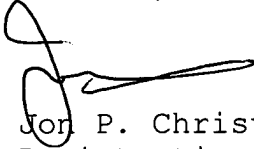
In Ex parte CARL A. LUNDGREN (Appeal No. 2003-2088, Application 08/093,516), The Board Of Patent Appeals And Interferences, in response to a Patent Office rejection on a technological arts standard, stated, inter alia, "that there is currently no judicially recognized separate 'technological arts' test to determine patent eligible subject matter under § 101. We decline to create one. Therefore, it is apparent that the examiner's rejection can not be sustained." Applicant therefore re-submits originally claimed subject matter as new claims 122 and 123 and as a more general expression of the current invention.

11. The allowance of claims 1-95 and 119, 120, 121, 122 and 123 as now presented, is believed to be in order and such action is earnestly solicited. Should the Examiner be of the opinion

that a telephone conference would expedite prosecution of the subject application, he is respectfully requested to telephone applicant's undersigned attorney.

Respectfully submitted,
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